

such that hybridization can occur" (page 9 top, Office Action) and pointed out from the bottom of page 7 to the top of page 9, that "Carrico (US Patent No. 5,200,313) discloses factors which affect hybridization reactions . . . " and points out that such factors were not explicitly considered in applicant's patent specification.

Applicants argue against the reasoning of the Examiner, namely that:

1. The specification supports the term "stringent conditions" in the middle of page 4 and thus applicants possessed this embodiment of the invention when filed. Moreover, as seen in some of the cited references (in particular, the oft-cited textbook of Maniatis et al. "Molecular Cloning" of 1989) a skilled artisan understood this term as referring to known conditions that easy and routinely are modified for any specific case; and

2. The Carrico reference U.S. No. 5,200,313 cited by the Examiner supports applicants' case for written description. Carrico is noteworthy because the invention described in Carrico was NOT a routine hybridization condition but rather a simplified technique that even unskilled workers could follow to obtain hybridization.

Carrico departed from routine methods of his day, which relied primarily on "adsorption onto a microporous membrane, such as nitrocellulose, or by covalent bonding to reactive sites on a solid support." Carrico provided a description of stringency conditions and factors because the Carrico invention eliminated "the high level of skill or to take the requisite time to perform the immobilization or labeling procedures" by providing the "probe already immobilized or in a readily immobilizable form such as by binding to an immobilized binding partner." (Last two paragraphs in Summary of the Invention). In other words, Carrico removed the need for routine experimentation of

stringency conditions for hybridization by an invention that provided hybridization to non-technical personnel.


In contrast, the present invention is meant to be carried out by regular skilled artisans. The specification does not require further explanation of what is already known, particularly by molecular biologists in a field that has advanced far.

Applicants point out that the latest priority date of the Carrico patent was 1985, 11 years before the priority date of the present application. Within the last 11 years, determining "stringency" conditions has become very routine and easy to do, particularly for skilled artisans that have a much higher level of skill compared with the users of the Carrico invention. A written description of stringency conditions thus is not required.

Reconsideration and allowance respectfully are requested. Should the Examiner have any questions regarding the present application or believe that further discussion will advance prosecution, the Examiner is invited to contact the undersigned at the number listed below.

Respectfully submitted,

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Date


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